

0154-2811-2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Vincent BERGER, et al : GROUP: 2815

SERIAL NO: 09/328,391 : EXAMINER: BROCK II, P.

FILED: June 9, 1999 :

FOR: QUANTUM WELL DETECTOR :
WITH LAYER FOR THE STORAGE
OF PHOTO-EXCITED ELECTRONS

PROVISIONAL ELECTION OF SPECIES

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Election of Species Requirement dated May 22, 2001, Applicants provisionally elect with traverse Species IA, drawn to the invention depicted in Figures 3 and 4, and lists Claims 1-3, 6 and 11-12 as readable thereon and Claims 1 and 2 as generic to all species,¹ Claim 3 as generic to Species IA, IB, and IC, and Claim 6 as generic to Species IA, IIA and IIIA. Applicants are entitled to consideration of claims, directed to additional non-elected species, which include the limitations of an allowable generic claim, as provided by 37 C.F.R. 1.141(a). Under the Office Action's framework, Applicants are not sure on which species Claim 12 reads since it recites 4 contact layers (so that it presumably does not read on Species I and II), but does not recite that they "are employed to create an electric field across a transfer barrier layer of constant composition" (so that it does not read on Species III either).

Applicants traverse the outstanding requirement as the outstanding requirement has

¹See the Election of Species Requirement at page 4, lines 7-8, also identifying Claims 1-2 as generic.

#11
Election
FJONBS
8-28-01

RECEIVED
TECHNOLOGY CENTER 2800
AUG 27 2001

not established that an undue burden would be required if the requirement was not issued and if all the claims were examined together. More particularly, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application no undue burden has been established if each of the claims were examined together. This application is relatively short, contains only 12 claims, with only 1 independent claim, so that it is unlikely that this application contains claims directed to nine "patentably distinct" species, especially since at least two of the claims are generic and several of the dependent claims depend on other dependent claims. The present requirement subjects the Applicants to the undue financial burden of prosecuting the invention in up to nine separate proceedings!

Furthermore, MPEP 806.04(f) states that "claims to be restricted to different species must recite the mutually exclusive characteristics of such species." However, the Election of Species Requirement fails to show that claims directed to different species are mutually exclusive. In particular, the Election of Species Requirement fails to show how Claim 6 is mutually exclusive from Claim 8, which is dependent on Claim 6.

Therefore, Applicants respectfully request that the requirement to elect a single disclosed species be reconsidered and withdrawn,² and that a full examination on the merits of Claims 1-12 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Philippe J.C. Signore, Ph.D.
Registration No. 43,922



22850

Tel. No.: (703) 413-3000
Fax No.: (703) 413-2220
GJM:PJCS:les

I:\atty\pjcs\0154.PJCS\01542811.ElectionResponse.wpd

²See MPEP 821.01.